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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,770	02/09/2004	Robert Lee Wells	8048C	8824

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THE PROCTER & GAMBLE COMPANY
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EXAMINER

TRAN, SUSAN T

ART UNIT PAPER NUMBER

1615

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,770

Applicant(s)

WELLS ET AL.

Examiner

Susan T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/24/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION

Receipt is acknowledged of applicant's Information Disclosure Statement filed 02/09/04 and 01/24/05.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Onitsuka et al. 5,635,461.

Onitsuka discloses a hair tinting shampoo in an aqueous medium comprising at least one direct dye, at least one anionic surfactant, one amphoteric surfactants, additives, and cationic polymers (see abstract, column 3, lines 22-67, column 4, and lines 1-17). Onitsuka also discloses the claimed amounts of all the ingredients (see abstract, and examples). The ingredients are prepared by mixing the individual ingredients in water, whereby premixes of the different compounds may also be used (see examples).

Onitsuka does not disclose the properties of the composition, such as water-soluble dye materials being concentrated in a dispersed phase of liquid emulsion to form droplets having average size between 0.05 μm and about 100 μm . However, where the claimed and prior art products are identical or substantially identical in

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structure or composition, or are produced by identical or substantially identical processes, a prima facie case of anticipation has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). Therefore, it is the position of the examiner that such property is inherent because Onitsuka discloses the use of the same materials prepared by the same method to obtain the same product, namely a hair color shampoo. Products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Grit EP 0 819 422 A1.

Grit teaches a stable composition for dyeing of human hair in aqueous carrier comprising 0.0001% to 2.5% of at least one cationic directly active hair dyestuff, 0.1% to 10% of at least one amphoteric surfactant, and 0.1% to 5% of at least one water-soluble UV-absorbing compound (see abstract, and pages 2-3). The composition further comprises cationic polymer in an amount of from about 0.1% to 2.5%, and usual additives, including silicone oils (pages 5-6). The composition is prepared by admixture of the ingredients (see examples).

Grit does not disclose the properties of the composition, such as water-soluble dye materials being concentrated in a dispersed phase of liquid emulsion to form

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droplets having average size between 0.05 μm and about 100 μm . However, where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of anticipation has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). Therefore, it is the position of the examiner that such property is inherent because Grit discloses the use of the same materials prepared by the same method to obtain the same product, namely a hair color rinse. Products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onitsuka et al. US 5,635,461.

Onitsuka is relied upon for the reason stated above. Onitsuka does not disclose the properties of the composition, such as water-soluble dye materials being concentrated in a dispersed phase of liquid emulsion to form droplets having average size between 0.05 μm and about 100 μm . However, where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection. There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102. *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). Therefore, it is the position of the examiner that the composition taught by Onitsuka would have the claimed properties because Onitsuka teaches the use of the same materials prepared by the same method to obtain the same product, namely a hair color shampoo. The burden is shifted to applicant to

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provide data showing that the composition of Onitsuka does not necessarily possess the characteristics of the claimed product.

It is noted that Onitsuka does not explicitly teach wetting the hair with water prior to the application of the color shampoo, however, it would have been obvious for one of ordinary skill in the art to apply water before applying shampoo, because Onitsuka teaches the color shampoo having good lathering, and well-foaming properties.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grit EP 0 819 422 A1.

Grit is relied upon for the reason stated above. Grit does not disclose the properties of the composition, such as water-soluble dye materials being concentrated in a dispersed phase of liquid emulsion to form droplets having average size between 0.05 μm and about 100 μm . However, where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection. There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102. *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA

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1977). Therefore, it is the position of the examiner that the composition taught by Grit would have the claimed properties because Grit teaches the use of the same materials prepared by the same method to obtain the same product, namely a stable color rinse. The burden is shifted to applicant to provide data showing that the composition of Grit does not necessarily possess the characteristics of the claimed product.

Pertinent Arts

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Saphakkul, and Houiellebecq et al. are cited as being of interest for the teachings of hair coloring formulations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan T. Tran whose telephone number is (571) 272-0606. The examiner can normally be reached on Monday through Thursday 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'S. Tran', with a long horizontal flourish extending to the right.

S. Tran
Patent Examiner
AU 1615